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EXAMINER
FADOK, MARK A

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/698,379
Filing Date: October 27, 2000
Appellant(s): MARTINEAU ET AL.

_____

Himanshu S. Amin
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

In accordance with "Order Returning Undocketed Appeal To Examiner mailed 2/9/2009, this Supplemental Examiner's Answer contains a new statement of rejection correcting what can be described as an inadvertent substitution of claim 6 in the statement of the rejection of claims 8 and 44. To correct this, the examiner's rejection under section 9 below has been changed to reflect in the statement of the rejection that claims 8 and 44 are rejected under Lee in view of NetGift.

This is in response to the appeal brief filed 11/27/2007 appealing from the Office action mailed 6/21/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

This appeal involves claims 8 and 44. These claims were inadvertently addressed in the body of the rejection under the statement of rejection of claim 6

on page 8 of the rejection mailed 6/21/2007. The correct statement of rejection should have been: --Claims 8 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of NetGift (a collection of articles and web pages see PTO 892, Netgiftl - Netgift7)--.

(7) Claims Appendix

A substantially correct copy of appealed claims 1-11 and 41-49 appears on page 9-17 of the Appendix to the appellant's brief. The minor errors are as follows: claims 12-40 are not designated as withdrawn.

(8) Evidence Relied Upon

| 7,013,292 | HSU et al. | 3-2006 |
| 6,611,814 | Lee et al. | 8-2003 |

NetGift, a collection of articles and webpages, see PTO 892 dated 6/21/2007.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed

invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351 (a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21 (2) of such treaty in the English language.

Claims 1,2,5,6,7,9,10,11,41,42,45,46,47 and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee (US 6,611,814).

In regards to claim 1, Lee discloses a system that facilitates electronic shopping through an electronic item list for items residing on the Internet comprising:
an item database holding information with respect to items, the information is at least one of an offer type, a general product type, a specific manufacturer type and a specific merchant type (FIG 13);
an item list database that stores an item list that includes a reference to at least one item associated with the information stored in the item database (FIG 11); and
an interface component that receives a request to display the item that is referenced in the item list, accesses the item list database to obtain the reference from the item list (FIG 2),
utilizes the reference as a key into the item database, retrieves data corresponding to the referenced item from the item database, and utilizes the retrieved data to display the item and associated information to the requester (FIG 12).

In regards to claim 2, Lee teaches the interface component degrades the display of the item as records are removed from the item database (FIG 12).

In regards to claim 5, Lee teaches a remote input component that allows a user to add an item to the item list, the item is a description that resides on a remote merchant's site, and the remote merchant site employs a link to the remote input component that invokes the remote input component (col 6, line 56 to col 7, line4).

In regards to claim 6, Lee teaches the remote input component adds the description of the item to the item list; the description includes one of structured and unstructured data (FIG 8).

In regards to claim 7, Lee teaches the description is linked to information associated with an item in the item database and the remote input component adds the linked information to the item list (FIG 8).

In regards to claim 9, Lee teaches the interface component comprises a plurality of ASP pages (col 6, lines 55-67, portal).

In regards to claim 10, Lee teaches at least one HTML page that allows a user to select items from an electronic web-site to add to the item list and at least one element that provides a link from a selected item to the interface component, the interface component adds the selected item to the item list (FIG 6).

In regards to claim 11, Lee teaches a gift finder component that is associated with the item list, the gift finder component accesses a user attribute database to retrieve attributes related to an owner of the item list, the gift finder component employs the retrieved attributes to extract data from the item database and returns at least one item based on the retrieved attributes (FIG 9).

In regards to claim 41, Lee discloses a method that provides an electronic item list for items residing on the Internet comprising:

providing an item database that stores information with respect to items, the information is at least one of an offer type, a general product type, a specifies manufacturer type and a specific merchant type; and

storing an item list in an item list database, the item list includes a reference to an item associated with the information stored in the item database,

the reference is utilized as a key into the item database to extract data corresponding to the referenced item from the item database and to display the referenced item and associated information (See response to claim 1).

In regards to claim 42, Lee teaches degrading the display of the item as records are removed from the item database (see response to claim 2).

In regards to claim 45, Lee teaches allowing a user to select an item from an electronic web-site to add to the item list, and adding the selected item to the item list (see response to claim 10).

In regards to claim 46, Lee teaches accessing a user attribute database to retrieve attributes related to an owner of the item employing the retrieved attributes to extract data from the item database; and returning the extracted data (see response to claim 11)

In regards to claim 47, Lee discloses a system that facilitates electronic shopping through an electronic item list for items residing on the Internet comprising:

means for storing information with respect to items, the information at least one of an offer type, a general product type, a specific manufacturer type and a specific merchant type;

means for storing an item list that includes a reference to an item associated with the stored information; and

means for receiving a request to display the referenced item, retrieving the reference, utilizing the reference as a key into the stored information, extracting data corresponding to the referenced item and utilizing the extracted data to display the item and associated information to the requester (see response to claim 1).

In regards to claim 48, Lee teaches means for degrading the display of the item as records ate removed from the stored information (see response to claim 2).

Claim Rejections - 35 USC § 103
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 3,4,43 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Hsu (US 7,013,292).

In regards to claim 3,4, and 43, Lee teaches gathering data from various websites and adding them to a gift list (structured data) and using profile preferences to suggest items that are not structured, but does not specifically mention that the unstructured data are custom items (see FIG 4 and 5, of applicant's PG PUB to this application US 20050182688). Hsu teaches registering selections available from a participating vendors and also having the option to add custom items that are not provided from selected vendors (col 16, lines 6-19 and col 24, col 10, lines 40-45 and lines 44-54, cash gifts and gift ideas out side the system selections). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Lee allowing the entry of custom items, because this will allow the recipient a greater selection and not limit the selections to only those available on the site, thus increasing sales by keeping the recipient and buyers at a particular site.

Start of new statement of rejection

Claims 8 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of NetGift (a collection of articles and web pages see PTO 892, Netgiftl - Netgift7).

End of new statement of rejection

In regards to claims 8 and 44, Lee teaches using an item list at a remote site, but does not specifically mention that the infrastructure of the item list appears to reside on the remote site. NetGift (a collection of articles and web pages see PTO 892, Netgiftl - Netgift7) teaches branding and packaging a linked registry at a remote partnering site (NetGift2, abstract). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Lee, linking the infrastructure of the item list to a remote site, the item list appears to reside on the remote site as is taught by Netgift, because this approach effectively extends each distribution and retailer's ability to generate transaction, thus increasing revenue (NetGift5).

(10) Response to Argument

In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., "ensuring that the current item information from the item database is provided",

"requiring the user to add products to buy to the wish list", "a user creating a

personalized list", "modifications to the item database being automatically updated", "if a

particular item is not available, the information is automatically retrieved from the

information database without requiring update of the affected item", "degrading the data

gracefully", "providing alternative information") are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the

specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993). The examiner by not addressing these features which

are not claimed, does not concede that these same benefits are not present in Lee or

the combination of Lee/Hsu and NetGift.

Appellant argues that Lee does not teach an "interface component that receives

a request to display the item that is referenced in the item list, accesses the item list

database to obtain the reference from the item list, utilizes the reference as a key into

the item database, retrieves data corresponding to the referenced item from the item

database, and utilizes the retrieved data to display the item and associated information

to the requester". As is quite clear in at least Fig's 3 and 4, Lee teaches an item list

database (virtual wish list 900, containing information that is later used as a key to

retrieve product listings) that can be accessed. This information is selected from the

item list that can be sent to the item database (FIG 4, item 122) that retrieves data that

corresponds to the referenced item in the virtual wish list (this could be any generic item

list such as a category or brand that describes what the recipient is interested in such as

shoes or a book (see applicant's specification FIG 6, item 122 text description and page

7 lines 5-12 which states "the interface component 30 retrieves information from the

item list database 26 and uses this information as keys into the various databases. The

interface component 30 then searches through at least one of the plurality of databases,

merchants 16, manufacturers 18, offers 20, products 22 and categories 24, and extracts

the necessary data for displaying the contents of the item list database 26. The

extraction process joins as much data as possible from the databases at render time").

The corresponding items are retrieved from the database displayed to the

shopper (FIG 4, item 410-414).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection (i.e. a new statement

of rejection) set forth in section **(9)** above. Accordingly, appellant must within **TWO**

MONTHS from the date of this answer exercise one of the following two options to avoid

sua sponte **dismissal of the appeal** as to the claims subject to the new ground of

rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the

primary examiner by filing a reply under 37 CFR 1.111 with or without amendment,

affidavit or other evidence. Any amendment, affidavit or other evidence must be

relevant to the new grounds of rejection. A request that complies with 37 CFR

41.39(b)(1) will be entered and considered. Any request that prosecution be reopened

will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply

brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of

rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the

other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR

41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be

treated as a request that prosecution be reopened before the primary examiner under

37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO

MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to

reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex

parte reexamination proceedings.

Respectfully submitted,

/Mark Fadok/

Primary Examiner, Art Unit 3625

A Technology Center Director or designee must personally approve the

new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn Coggins/

Director TC 3600

Conferees:

/J. A. S./

Jeffrey Smith

Supervisory Patent Examiner, Art Unit 3625

/Vincent Millin/

Appeal Conference Specialist